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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,094	04/18/2001	James M. Sheppard JR.	3129	8428

7590 11/01/2007
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EXAMINER

JOHNSON, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/837,094	Applicant(s) SHEPPARD, JAMES M.	
	Examiner Jenna-Leigh Johnson	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the response filed under 37 CFR 1.111 on August 28, 2007, requesting that prosecution be reopened since the Examiner's Answer included a new grounds of rejection.

PROSECUTION IS HEREBY REOPENED.

2. The amendment filed on August 28, 2007 has been entered. Claims 1 – 20 and 23 have been cancelled. Claims 24 and 25 have been amended. Claims 21, 22, 24 – 30, and 32 – 36 are pending.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 21, 22, and 24 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark in view of Parker et al. and Sherrill et al.

5. Claims 21, 22, and 24 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. and Stark, Terrasse, and Sherrill et al.

Double Patenting

6. Claims 21, 22, and 24 – 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21,22, 24 – 30, and 32 – 36 of copending Application No. 09/747,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the jacquard loom recited in 09/747,529 and the dobby loom recited in this application can be used to produce the same simple fabric construction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. First, the applicant argues that Parker et al. does not teach a weave structure which has

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borders produced with contrasting colors (response, page 4). However, on page 1, lines 28 – 35, Parker et al. teaches that the cross borders of the woven fabric is produced by using contrasting colors. Further, it is noted that Terrasse is also relied on to teach the claimed woven fabric pattern with a central region surrounded by a border region made from a different color. Therefore, the features of the claimed weave pattern are disclosed by the prior art.

8. Further, the applicant argues that the combination of references fail to teach the limitation that the border regions and opposite central area are capable of masking print or bleed through (response, page 5). However, it is noted that this limitation is not positively recited by the applicant. First, the claim states that the graphic impression *may* overlap the border. The image is not required to overlap the border region and Stark teaches that the print can be applied in registry with the woven pattern. Thus, the printed image would not be in the border region and the border would not have any printing to mask. And the features of the claim are met by the combination of Parker et al., Stark, Terrasse and Sherrill et al.

Second, the applicant recites that the regions have two colors one being a *lighter* color and one being a *darker* color. These colors are only defined relative to each other and the applicant does not require any specific color selections. Further, the claim recites that the border is capable of masking a possible printed image and potential bleed, but does not recite any specific dye colors which need to be masked. The claim does not positively state the border is printed or the print has bled through the fabric. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Further, any light or darker colors inherently have the ability to mask some colors. And even if a color does not mask many colors it will at least mask a print color which is identical or very similar in color to the fabric colors, i.e., white would mask white. Therefore, the different colored fabric sections which are disclosed by the prior art references would inherently have

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the ability to mask some colors and meets the recited limitation that the different colored sections are capable of masking printing colors.

Also, it is noted that no color would be able to mask every possible printed color. Even a dark color like black would not be able to mask light colors like white. Thus, the claimed lighter and darker colors would only have the capability of masking some colors, which is inherently true for all colors. And, the applicant is not claiming that borders are specific colors or that the print is specific colors, or even that the borders are positively printed on or that the borders positively mask specific colors. The claim only requires that regions adjacent to and opposite from the printed central area have the ability to mask some colors, which would be true no matter what colors are chosen. Therefore, the rejection is maintained.

9. Further, as shown by the prior art, all the claimed elements, i.e., woven patterned fabrics with borders and printing pile and patterned fabrics, were known in the prior art and one of ordinary skill in the art would have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. And the technique for improving a particular product, i.e., printing desired designs, was part of the ordinary capabilities of person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations. Finally, the claim would have been obvious because design incentives provides a reason to make an adaptation, i.e., to create desired visual appearances, and the invention resulted from application of the prior knowledge in a predictable manner. Thus, the rejection is maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Johnson whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlj
October 29, 2007

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/Jenna-Leigh Johnson/
Primary Examiner
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